

REMARKS

By the foregoing Amendment, applicant has amended independent claim 5 to clarify the claim as requested by the Examiner and to more particularly emphasize the inventive features of the invention.

Applicant appreciates the Examiner's withdrawal of the Final Rejection and, by the foregoing Amendment, Applicant notes that claims 5 and 7 remain pending, all other claims being previously cancelled.

In response to the Examiner's objection of claim 5 because of an informality, the comma after the word "composition" in line 5 of claim 5 has been deleted and replaced by the word "and." Accordingly, withdrawal of the rejection is respectfully requested.

Reconsideration and withdrawal of the rejection of claims 5 and 7 under 35 U.S.C. §112, 2nd paragraph, is respectfully requested.

Regarding claim 5, the limitation "the composition" in line 5 has been amended to refer back to the "polymeric composition," thereby mooting this ground of rejection.

Reconsideration of the previous rejection of claim 5 under 35 U.S.C. §102(e) as being anticipated by Wang et al (U.S. Patent 6,048,679) is respectfully requested in view of the following comments.

Contrary to the Examiner's assumptions made in the body of the rejection, Wang et al does not anticipate a support (where the support is paper or otherwise), coated and in direct contact with a film of a conductive polymer composition as allegedly taught in the abstract of Wang et al.

Rather, if the Examiner would carefully read the reference, it is clear that a support (being paper or otherwise) bears at least one photographic layer, e.g., "blue-sensitive silver halide emulsion

layer having associated therewith a yellow image dye-providing material, at least one green-sensitive silver halide emulsion layer having associated therewith a magenta image dye-providing material and at least one red-sensitive silver halide emulsion layer having associated therewith a cyan image dye-providing material” to provide a photographic paper; column 8, lines 55-62. An alternative would be a simple black-and white or monochrome elements-containing layer as described at column 8, lines 43-46.

However, whether one skilled in the art were producing the photographic element in either black and white, monochrome or color, it is clear that such color layers are placed against the support (and not a polymeric composition “being deposited directly on and in contact with said paper in an aqueous form and dried to form said film of polymer composition to impart a static dissipative property and a conductive property to said paper layer”) as claimed in claim 5 (as amended).

Thus, there is no direct contact of the polymeric layer containing a quaternary ammonium compound as claimed.

The undersigned has carefully read the portions of Wang et al pointed out by the Examiner (column 9, lines 2-5; column 4, lines 66-67; column 3, lines 27-61; column 5, lines 41-48; column 4, lines 34-54; column 6, lines 24-37; and the Abstract) and finds no teaching therein, nor at any other place in Wang et al, of the claimed invention. Further, although column 1, lines 60-63 is noted, those remarks are directed to the “Background” art. There is insufficient disclosure in that section to teach the claimed invention. Having failed to find a disclosure of the claimed invention in a single (Wang et al) reference, Wang et al cannot possibly act as an anticipatory reference under 35 U.S.C. §102(e). Furthermore, applicant notes that independent claim has also been amended to recite the

specific amounts of 1-10 wt% based on the weight of the polymeric composition, which is nowhere found in the Wang et al reference.

For all the foregoing reasons, withdrawal of the rejection of alleged anticipation based on Wang et al is respectfully requested.

Reconsideration of the previous rejection of claim 7 under 35 U.S.C. §103 as being unpatentable over Wang et al in view of Lu et al (U.S. Patent 5,130,177) is respectfully requested in view of the following comments.

The deficiencies of Wang et al are not cured by the citation of Lu et al. Moreover, Lu et al does not teach the formation of a “intermediate composition comprising aqueous methyl methacrylate polymer based solution containing a quaternary ammonium compound in an amount of 1-10 wt% based on the weight of the polymeric composition and a polyethylene wax . . .” as recited in independent claim 5 and, thus, incorporated by reference into dependent claim 7. To the contrary, Lu et al may employ a quaternary ammonium compound along and not in combination with a polymeric material at all. As disclosed at column 4, line 39 *et seq.* of Lu et al “the coating can consist entirely of the di-quaternary ammonium compound” Although patentees continue at column 5, line 11 *et seq.* that some types of binders may be used, there is no teaching of “methyl methacrylate polymer base solution” as recited in independent claim 5 and incorporated by statute (35 U.S.C. §112, fourth paragraph) into dependent claim 7. For the foregoing reasons, applicant respectfully submit that the proposed combination of Lu et al and Wang et al is based entirely on hindsight reconstruction of the invention and the proposed combination of references would not have been obvious to one of ordinary skill in the art at the time the invention was made since, even with

the proposed combination of references, the deficiencies of Wang et al have not been overcome. Therefore, for the foregoing reasons, withdrawal of all rejections and objections to the claims and passage of the application to issue are respectfully requested.

Applicant again reminds the Examiner of the Board of Patent Appeals and Interference's Decision in Ex Parte Levengood, 28 U.S.P.Q. 2d 1300, 1302 (BPAI 1993) wherein it was stated:

“Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that ‘would lead’ that individual to combine the relevant teachings of the references (citations omitted). Accordingly, the Examiner cannot establish obviousness by locating references which describe various aspects of the patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.”

Respectfully submitted,



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